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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,631	05/25/2000	William H. Barber	387953	5757

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BOULDER, CO 80301

EXAMINER

BARTUSKA, FRANCIS JOHN

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 01/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/578,631

Applicant(s)

BARBER, WILLIAM H.

Examiner

F. J. BARTUSKA

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-83 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 18-56 and 59-83 is/are rejected.
- 7) ☒ Claim(s) 16, 17, 57 and 58 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

The Declaration filed on 06 November 2003 under 37 CFR 1.131 has been considered but is ineffective to overcome the Kanoh et al and Kitchen et al references.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Kanoh et al and Kitchen et al references. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

Exhibits 1, 2 and 3 of the Declaration have not presented any more than a vague idea of the problem: "Provide a convenient way for the public to rent or buy movies thru the latest technology". Exhibits 1, 2 and 3 of the Declaration have not presented any means to solve the problem or any interactions between the means. Exhibits 1, 2 and 3 of

the Declaration do not show or disclose the claimed kiosk or the first processor receiving a request for an optical storage media and billing information from a user, transmitting the billing information to a system server, receiving confirmation of billing from the server or a second processor receiving billing information from the server, performing a credit verification, transmitting the confirmation to the first processor and transmitting an electronic receipt to the user. The disclosed Customized or Specialized vending machines disclosed on page 9 of Exhibit 1 is not demonstrative evidence of conception because there is no disclosure of how the vending machines are customized or specialized.

The Declaration of Scott Mackey, Exhibit 3, does not supply any evidence of a complete disclosure. Business plans and Excel charts are referred to in the Declaration of Scott Mackey but the contents of these business plans and Excel charts are not described in any detail and certainly not in sufficient detail to conclude conception of the invention.

“[C]onception is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice

without the exercise of extensive experimentation or the exercise of inventive skill.” *Hiatt v. Ziegler*, 179 USPQ 757,763 (Bd. Pat. Inter. 1973)

The Declaration filed 06 November 2003 has not established conception before the date of Exhibit 4, June 17, 1998.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35

U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-8, 18, 20-24, 26-29, 36-38, 42-53, 59-65, 67-70, 77-79 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Kitchen et al. Kanoh et al show kiosks 3, which dispense CDs, see col. 1, lines 7-12, and receive them back. The kiosks of Kanoh et al are connected to a remote host computer 50, see col. 5, lines 33-40. Kanoh et al include a reader 61 that reads bar codes on the CDs and indicates when a CD is erroneously returned, see col. 6, lines 13-16. Kanoh et al maintain an inventory of the rented CDs and the location of the CDs in the kiosk, see col. 7, lines 35-64. Kanoh et al disclose electronic transmission of charges to a credit card company, see col. 4, lines 28-31 and 47-49 and col. 9, lines 43-50 and col. 10, lines 5-12. However, Kanoh et al do not disclose electronically transmitting a receipt to the user. Kitchen et al disclose electronically presenting bills including credit card bills to the payor, see col. 6, line 6. Since credit card bills show charges for purchases and services and payments received it comprises a receipt. It would have been obvious to one of

ordinary skill in the art in view of the showing and teaching of Kitchen et al to provide the device of Kanoh et al with means to electronically transmit the credit card bill to the customer to provide the customer with a record of the transaction.

Claims 30-32, 71 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Kitchen et al as applied to claim 2 above, and further in view of Brindze et al. Kanoh et al, as modified by Kitchen et al, disclose all the features of the applicant's claimed invention except concentric markings on the CDs. Brindze et al show CDs with unique concentric markings to keep track of each CD. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Brindze et al to provide the CDs of Kanoh et al with unique concentric markings to keep track of each CD.

Claims 9-12 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Kitchen et al as applied to claim 1 above further in view of Reid et al. Kanoh et al, as modified by O'Neil et al, show all the features of the applicant's claimed invention except a storage carousel for the CDs. Reid et al show a storage

carousel 32 for holding the articles. It would have been obvious to one of ordinary skill in the art to substitute the carousel of Reid et al for the storage means of Kanoh et al since they are equivalent and either would work equally well in the dispenser of Kanoh et al.

Claims 13, 54, 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Kitchen et al as applied to claim 1 above further in view of Takahashi et al. Kanoh et al, as modified by Kitchen et al, disclose all the features of the applicant's claimed invention except the device to polish the CDs. It would have been obvious to one of ordinary skill in the art in view of the CD polishing device shown in Takahashi et al to provide the device of Kanoh et al with a device to polish the CDs to remove scratches or stains from the CDs.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Kitchen et al as applied to claim 2 above, and further in view of Takahashi et al. Kanoh et al, as modified by Kitchen et al, disclose all the features of the applicant's claimed invention except the device to polish the CDs. It would have

been obvious to one of ordinary skill in the art in view of the CD polishing device shown in Takahashi et al to provide the device of Kanoh et al with a device to polish the CDs to remove scratches or stains from the CDs.

Claims 25, 34, 35, 66, 75 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Kitchen et al as applied to claim 1 above further et al in view of Dedrick. Kanoh et al, as modified by Kitchen et al, show all the features of the applicant's claimed invention except sending advertisements according to a user profile. Dedrick discloses sending advertisements according to a user profile. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Dedrick to tailor the advertisement in Kanoh et al according to user profiles.

Claims 33, 73 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Kitchen et al as applied to claim 1 above further in view of Iida. Kanoh et al, as modified by Kitchen et al, show all the features of the applicant's claimed invention except an optical writing system. Iida disclose an optical writer 28 that

writes data to the CDs. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Iida to provide the device of Kanoh et al with an optical writer to write data to the CDs.

Claims 39-41 and 80-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Kitchen et al as applied to claim 1 above further in view of Iida. Kanoh et al, as modified by Kitchen et al, show all the features of the applicant's claimed invention except a casing with an address and packaging for mailing. Iida discloses a casing and address label and packaging for mailing the CDs in col. 15, lines 16-22. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Iida to provide the device of Kanoh et al with a casing and means to address and mail the CDs.

Allowable Subject Matter

Claims 16, 17, 57 and 58 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in

independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

The applicants' remarks have been considered but have not been found persuasive because the Declaration under 37 CFR 1.131 has been found insufficient. Also, the combination of Kanoh et al and Kitchen et al does not involve hindsight because providing the customer with a record of the transaction is motivation to combine the references.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated

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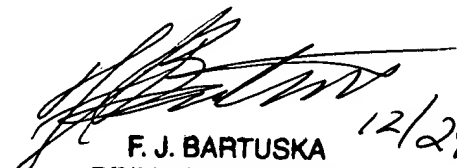
from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. J. BARTUSKA whose telephone number is 703-308-1111. The examiner can normally be reached on MONDAY-FRIDAY (ALTERNATE FRIDAYS OFF).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ROBERT P. OLSZEWSKI can be reached on 703-308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

fjb


F. J. BARTUSKA
PRIMARY EXAMINER
12/24/03